

Notice of Allowability

Application No.

09/841,158

Examiner

Fozia M Hamud

Applicant(s)

BEASLEY ET AL

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 08/18/03.
2. ☒ The allowed claim(s) is/are 4, 8, 9, 24-25, 27-29 (now renumbered 1-8, respectively).
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 3 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. <u>12/01/03</u> | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Election/Restriction:

1. Applicant's election with traverse of SEQ ID NO:1, filed on 18 August 2003 is acknowledged. The traversal is on the grounds that according to MPEP § 2434, nucleotide sequences encoding the same protein are not considered to be independent and distinct and will continue to be examined together. Therefore, since the cDNA of SEQ ID NO:1 and the genomic sequence of SEQ ID NO:5 both encode the amino acid of SEQ ID NO:3, these two sequences should not be restricted.

This ground of traversal has been fully considered but is not deemed persuasive, because, nucleic acid of SEQ ID No: 1 consists of 1722 bases while that of SEQ ID NO:5 consists of 27,067 bases, therefore, these two sequences are not obvious over one another. The instant specification discloses that the nucleic acid of SEQ ID NO:1 encodes a transcobalamin II protein, and therefore, can be utilized as such. However, instant specification does not disclose a specific or substantial utility for the nucleic acid of SEQ ID NO:5, neither does it disclose the encoded product of the nucleic acid of SEQ ID NO:5. Furthermore, searching more than one product is always burdensome on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Status of Claims:

2. Claims 1-3, 5-7, 10-23 have been canceled in the amendment filed on 26 August 2002. Claims 4, 8, 9 have been amended. New claims 24-29 have been added. Thus claims 4, 8, 9 and 24-29 are pending, of which claims 4, 8, 9 and 24-25, 27-29 are

under consideration. Claim 26 is withdrawn from prosecution as being drawn to a non-elected invention.

Examiner's Amendment

3. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R § 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the Issue Fee.

Authorization for this Examiner's Amendment was given in a telephone interview with Attorney Justin D. Karjala on 01 December 2003.

4. The application has been amended as follows:

IN THE CLAIMS:

4a. In claim 28, line 3, after "SEQ ID NO:3" delete "may be" substitute therefor --is--

4b. Please cancel claim 6 without prejudice or disclaimer.

Information Disclosure Statement:

5a. All of the references cited in the Search Reports (PTO-1449 forms) submitted by Applicants on 01 December 2003 have been considered by the Examiner.

REASONS FOR ALLOWANCE:

6. Claims 4, 8, 9 and 24-29 have been allowed, because Applicants' argument that the polypeptide of SEQ ID NO:3 of the instant invention is a transcobalamin II protein, and is therefore, supported by patentable utilities that meet the requirement 35 U.S.C. § 101, has been found persuasive. Applicants provide strong evidence that the polypeptide of the instant invention is a transcobalamin II, since each of the top ten

Art Unit: 1647

BLAST hits are all either transcobalamin II or transcobalamin II precursors, which clearly indicates that the skilled artisan would undoubtedly classify the polypeptide of SEQ ID NO:3 as a transcobalamin II.


Advisory Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday, Wednesday-Thursday, 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1647
01 December 2003


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600